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09/620,617	07/21/2000	Terry A. Smith	10991929-1	4729

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EXAMINER

PARK, CHAN S

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 12/19/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/620,617

Applicant(s)

SMITH ET AL.

Examiner

CHAN S PARK

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities:  
"Identification" in line 8, page 2 should not be capitalized.
2. The disclosure is objected to because of the following informalities: Unclear statement in page 3, lines 19-20. It is not clear as to what the applicant intends to disclose when it reads "... the present invention of the present invention will become..."

Appropriate correction is required.

### ***Claim Objections***

The following quotations of 37 CFR § 1.75(d)(1) is the basis of objection:

(d)(1) The claim or claims must conform of the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a)).

3. Claim 3 is objected to under 37 CFR § 1.75 as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "the named" in line 3 lacks proper antecedent basis.

### ***Double Patenting***

4. Claims 1-20 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-20 of copending Application No. 09620957. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: when claims 1 through 20 of copending Application No. 09620957 are rewritten in independent forms including all the limitations of the each claim, it would cover all the limitations of current claims cited in Application No. 09620617.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2-4 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claims 2-4 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No. 1 filed July 21, 2000. In that paper, applicant has stated only three algorithms, and this statement indicates that the invention is different from what is defined in the claim(s) because introduce three more algorithms in addition to the first algorithm as disclosed in claim 1.

It is further noted that if the form is a background image, the third printing algorithm is applied according to the specification (page 10, lines 1-4). Therefore, it is uncertain as to what the applicant is claiming in claim 4 when the claim cites a fourth printing algorithm with the background image.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 and 8-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Gauthier et al. U.S. Patent No. 6,243,172.

6. With respect to claim 1, the Gauthier et al. reference discloses a printer (high-speed printing system in fig. 1), comprising:

An I/O port capable of receiving a plurality of commands describing a document (job ticket 12 in conjunction with PDL files 14 and 15), the commands including both a named sequence describing a form (PDL files) and an indicator (commands sent from operator control system 20 of col. 5, lines 14-16);

First means for responding to the indicator indicating permission is granted to print each instance of the form (col. 5, lines 35-41) from the same video data (variable

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data), by processing and printing the named sequence according to a first printing algorithm (col. 6, lines 7-32).

The Office has interpreted accessing a copy 27' of the display list of the sub-template corresponding to the place holder and then merging the rendering commands from the display list of the sub-template 27' with the merged display list 30 in col. 6, lines 17-22, as the applicant's claimed first printing algorithm.

Furthermore, the reference teaches that the PDL command files are PostScript specifications created by an applicant program (col. 5, lines 24-27). Therefore, it is inherent that the printer has an I/O port to receive the files.

7. With respect to claim 2, the Gauthier et al. reference discloses a printer, further comprising:

Second means for responding to the indicator indicating each instance of the form is to be printed from new video data (variable data), by processing and printing the named sequence according to a second printing algorithm (col. 6, lines 7-32).

In a case when a place holder is not detected, the reference teaches that the printer takes other method or algorithm than the first printing algorithm discussed in rejection for claim 1. The office has read the other algorithm as a second algorithm.

8. With respect to claim 3, the Gauthier et al. reference discloses a printer, further comprising:

Third means for responding to the indicator indicating that the form is a fixed form (static data), by processing and printing the named sequence according to a third algorithm (col. 7, lines 7-15).

9. With respect to claim 4, the Gauthier et al. reference discloses a printer, further comprising:

Fourth means for responding to the indicator indicating that the form is a background image (display list), by applying a fourth printing algorithm to process and print the named sequence (col. 5, line 65 – col. 6, line 6).

10. With respect to claim 8, the Gauthier et al. reference teaches a method of processing and printing a named sequence describing a form, comprising:

Receiving the named sequence (PDL files 14 and 15) and an associated parameter (job ticket 12 in col. 5, lines 7-15);

Responding to the parameter being set to a first value, indicating permission is granted to print each instance of the form (col. 5, lines 34-41) from the same video data (variable data), by converting the named sequence into video data (graphic state) and then using the video data to print each instance of the form (col. 5, lines 45-51).

Note that Gauthier et al. calls raster image (converted video data) as graphic attributes (col. 1, lines 57). Furthermore, these bitmap will be printed on a hard copy or copies of documents (col. 1, lines 26-31).

The Office has interpreted accessing a copy 27' of the display list of the sub-template corresponding to the place holder and then merging the rendering commands from the display list of the sub-template 27' with the merged display list 30 in col. 6, lines 17-22, as the applicant's claimed first printing method disclosed in claim 8.

11. With respect to claim 9, the Gauthier et al. reference teaches a method of processing and printing a named sequence describing a form, further comprising:

Responding to the parameter being set to a second value, indicating that each instance of the form is to be printed from new video data (variable data), by generating new video data to print each instance of the form (col. 6, lines 7-32).

In a case when a place holder is not detected, the reference teaches that the printer takes other method or algorithm than the first printing method discussed in rejection for claim 8. The office has read the other method as a second printing method disclosed in claim 9.

12. With respect to claim 10, the Gauthier et al. reference teaches a method of processing and printing a named sequence describing a form, further comprising:

Responding to the parameter being set to a second value, indicating each instance of the form is to be printed from new video data (variable data), by converting the named sequence into display list data (graphic state) and then using the display list data to print each instance of the form (col. 6, lines 7-32).

Note that Gauthier et al. calls raster image (converted video data) as graphic attributes (col. 1, lines 57). Furthermore, these bitmap will be printed on a hard copy or copies of documents (col. 1, lines 26-31).

In a case when a place holder is not detected, the reference teaches that the printer takes other method or algorithm than the first printing method discussed in rejection for claim 8. The office has read the otehr method as a second printing method disclosed in claim 9.



The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-7 and 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gauthier et al.

13. With respect to claims 5 and 6, the Gauthier et al. reference discloses all the limitations disclosed in claim 1, but it does not explicitly disclose if the plurality of commands and the indicator are received from a computer externally connected to the I/O port.

However, the reference teaches that the PDL files can be PostScript create by an application program such as a wordprocessor, illustrator, or CAD system which further implies that a computer can create the PDL files (col. 5, lines 24-27). Furthermore, Examiner takes Official Notice that receiving plurality of commands and other print data from a computer externally connected to the I/O port is well known in printer technology.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the Gauthier et al. printer to receive the commands from a computer externally connected to the I/O ports.

The suggestion for doing so would have been to transmit the print data from distant location from the printer using a network connection.

14. With respect to claim 7, arguments analogous to those presented for claim 5, are applicable.

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15. With respect to claim 11, arguments analogous to those presented for claim 5, are applicable.

16. With respect to claim 12, arguments analogous to those presented for claim 5, are applicable.

17. With respect to claim 13, the reference discloses step of flagging the display list data as a candidate for caching (col. 5, lines 46-48).

18. With respect to claim 14, as noted in claim 1, the Gauthier et al. reference discloses a printer (high-speed printing system in fig. 1), comprising:

An I/O port capable of receiving a plurality of commands describing a document (job ticket 12 in conjunction with PDL files 14 and 15), the commands including both a named sequence describing a form (PDL files) and at least one command indicating permission is granted (commands sent from operator control system 20 of col. 5, lines 14-16) to convert the named sequence once into video data and then print each instance of the form from the video data.

Note that Gauthier et al. calls raster image (converted video data) as graphic attributes (col. 1, lines 57). Furthermore, these bitmap will be printed on a hard copy or copies of documents (col. 1, lines 26-31).

The reference, however, does not explicitly disclose where the data is generated. Although a computer is not disclosed for generating a print data, the reference teaches that the PDL files can be PostScript create by an application program such as a wordprocessor, illustrator, or CAD system (col. 5, lines 24-27).

Examiner takes Official Notice that creating and transmitting plurality of commands and other print data from a computer externally connected to the I/O port or network is well known in printer technology.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the Gauthier et al. printer to receive the commands generated by a computer externally connected to the I/O ports.

The suggestion/motivation for doing so would have been to implement the Gauthier et al. printer in the network system for a broad printing communication.

19. With respect to claim 15, arguments analogous to those presented for claims 8 and 14, are applicable.

20. With respect to claim 16, arguments analogous to those presented for claims 9 and 14, are applicable.

21. With respect to claim 17, arguments analogous to those presented for claims 10 and 14, are applicable.

22. With respect to claim 18, the Gauthier et al. reference discloses that the printer is responsive to the plurality of commands by printing the document (col. 10, lines 10-42).

23. With respect to claim 19, arguments analogous to those presented for claim 14, are applicable.

24. With respect to claim 20, the Gauthier et al. reference discloses that the plurality of commands form a print job (col. 10, lines 10-42).

***Conclusion***

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 6,014,629 to DeBruin-Ashton discloses a printing method for printing directory using customer database and mapping with health care provider service.


26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (703) 305-2448. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

Csp

December 12, 2003

  
EDWARD COLES  
SUPERVISORY PATENT EXAMINER  
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